

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN C. GOODWIN III

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Appeal No. 1997-0344  
Application 08/326,922

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ON BRIEF

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Before HAIRSTON, KRASS, and FRAHM, Administrative Patent Judges.

FRAHM, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1 to 14, which constitute all of the pending claims in the case before us.

BACKGROUND

The subject matter on appeal is directed to a price maintenance system and method employing a computer with a price-lookup (PLU) file and a point-of-service system including a bar code scanner,

label printer, and display (see specification, pages 2 to 3). As indicated in the specification (see pages 2 to 3), the price-lookup file is updated when prices are changed and the price-lookup file is used for printing labels and displaying information on prices. By sharing the updated price information with the point-of-service system and label printer or electronic shelf label system, appellant's price maintenance system and method avoid price mismatch. Price mismatch is defined as "a difference between a price printed on a label and a price within the PLU file used by the bar code scanner and terminal" (specification, page 2).

Representative independent claim 1 is reproduced below:

1. A price maintenance system comprising:

a point-of-service system including a bar code scanner, and a price-lookup file used by the bar code scanner to determine prices of scanned items; and

a computer coupled to the point-of-service system which updates the prices within the price-lookup file and sends the updated prices to a label printing routine to avoid price mismatch between the price-lookup file and a printed label on an item whose price has changed.

Representative independent claim 6 is reproduced below:

6. A price maintenance system comprising:

an electronic shelf label system;

a point-of-service system including a bar code scanner, and a price-lookup file used by the bar code scanner to determine prices of scanned items and used by the electronic shelf label system to display prices; and

a computer coupled to the point-of-service system and the electronic shelf label system which

updates the prices within the price-lookup file and individually sends the updated prices to a label printing routine as they are updated to avoid price mismatch between the price-lookup file and a printed label on an item whose price has changed.

The following references are relied on by the examiner:

Blanford	4,679,154	Jul. 7, 1987
Hunt	5,111,196	May 5, 1992
Swartz	5,448,046	Sep. 5, 1995 (filed Aug. 18, 1994)

Claims 1 to 14 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner apparently relies upon Swartz in view of Hunt and Blanford. We note that the Answer fails to state the grounds of rejection other than to list the prior art relied upon as being Swartz, Hunt, and Blanford (Answer, page 1). The Answer at page 2 also incorrectly addresses the Brief's listing of the only issue being whether claims 1 to 14 are patentable over Swartz in view of certain other secondary references (Brief, page 2) as being correct since the examiner has apparently dropped certain secondary references from the rejection (e.g., Davis, Harris, Wolfe, Collins, Goodwin, Failing, and "etc." are no longer relied upon). Because the examiner has only listed and has only discussed the references to Swartz, Hunt, and Blanford, we assume the rejection to be one under 35 U.S.C. § 103 over Swartz in view of Hunt and Blanford.

Rather than repeat the positions of appellant and the examiner, reference is made to the Brief and the Answer for the respective details thereof.

OPINION

It is our view, after consideration of the record before us, that the examiner has failed to make out a prima facie case of obviousness under 35 U.S.C. § 103. In reaching our conclusion on the issue raised in this appeal, we have carefully considered appellant's specification and claims, the applied references, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we find that the examiner has failed to meet his burden of adequately showing that Swartz in view of Hunt and Blanford taught or would have suggested the combination of features of claims 1 to 14 on appeal of a price maintenance system and method. Accordingly, we will reverse the examiner's decision rejecting claims 1 to 14 on appeal as being obvious under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837

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F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

We find that the examiner, at pages 3 to 9 of the Answer, has not met his burden of establishing a prima facie case of obviousness. The examiner has failed to establish a factual basis to support the legal conclusion of obviousness. In particular, the examiner has failed to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. at 17, 148 USPQ at 467, and the examiner has failed to provide a reason why one having ordinary skill in the pertinent art would have been led to modify Swartz or to combine Swartz, Hunt, and Blanford to arrive at the claimed invention. No motivation or rationale has been provided by the examiner as to how or why the applied references would be combined. The examiner has failed to point to some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art which would have led the artisan to combine the applied references. Lastly, there is no explanation in the Answer or any other office action, as to how the references would be combined to achieve the invention of

appellant's claims 1 to 14.

The examiner is correct that Swartz (column 1, lines 25 to 36 and column 2, lines 29 to 49) teaches a point-of-sale system which updates and prints out price information so as to minimize price mismatch (see Answer, page 5). The examiner is also correct that Hunt (Figure 10 and columns 7 to 8) teaches displaying price data in a point-of-sale system to avoid price

mismatch and that Blanford (Figure 4) teaches a price-lookup file and a CPU (see Answer, page 5).

However, the examiner has failed to point out which reference is relied upon to teach which elements of the claims. The examiner has nowhere provided a statement addressing the underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; and (3) the differences between the claimed invention and the prior art. Accordingly, we cannot sustain the rejection of claims 1 to 14 under 35 U.S.C. § 103.

Appellants argue (Brief, pages 7 to 13) that the rejection of claims 1 to 14 is improper because the examiner has not adequately shown that the cited references (Swartz, Hunt, and Blanford) teach or suggest each and every element as recited in combination in the claims. We agree. The examiner has failed to meet the requirements for an Answer set forth in 37 CFR 1.193(a) and in MPEP 1208 of stating where in the references each specific limitation of appellant's claims is found, identifying any

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differences in the claims and the prior art, and explaining how and why the claims are unpatentable over the prior art.

In view of the foregoing, the decision of the examiner rejecting claims 1 to 14 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSON	)
Administrative Patent Judge	)
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ERROL A. KRASS  
Administrative Patent Judge

ERIC FRAHM  
Administrative Patent Judge

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